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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,877	05/23/2001	Takaaki Amano	100809-16253 (SCET 18.699	9471
7590 10/22/2004 KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK,, NY 10022-2585			EXAMINER JANVIER, JEAN D	
			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/863,877

Applicant(s)

AMANO ET AL.

Examiner

Jean D Janvier

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### **Detailed Action**

### **Specification**

The title of the invention is not descriptive so as to help one having ordinary skill in the art understand the nature of the subject matter. A new title is required that is clearly indicative of the invention to which the claims are directed. Further, the abstract should not exceed 15 lines (Ca. 150 words). See 37 CFR 1.72.

### **Status of the claims**

Claims 1-9 are now pending in the Instant Application.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the

Art Unit: 3622

progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the

Art Unit: 3622

claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract

Art Unit: 3622

idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*.

However, State Street never addressed the second part of the analysis, i.e., the

"technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Claims 8 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. In fact, the process or steps disclosed in independent claims 8 and 9 pertain to a manual process and therefore, the claims do not fall within the technological art. In other words, the steps or process recited in claims 8 and 9 should be implemented via a device, such as a computer system, a computer database, a data communication, computer network, the Internet and so and so forth and the hardware or computer hardware should be incorporated in the bodies of the claims.

Furthermore, it is not clear whether the claims pertain to a computer readable medium having encoded thereon computer codes or computer instructions to perform the steps of the method or to a computer program or software per se (non-statutory).

If the Applicant intends to claim a computer readable medium, then the Applicant is encouraged to use the following format-

Art Unit: 3622

A computer readable medium (a computer program product) having encoded thereon computer codes when executed on a processor perform the step of-

Accepting identification...

Applying a point...

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite (confusing or ambiguous) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Here, it is not clear whether the claims pertain to a computer readable medium having encoded thereon computer codes or computer instructions to perform the steps of the method or to a computer program or software per se (non-statutory).

Claims 3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite (confusing or ambiguous) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3622

Regarding claim 3, in the limitations "said rule is determined in a **such a manner..** ", the phrase "**such a manner**) renders the claim indefinite for being unclear (does not clearly define the metes and bounds of the claim). See MPEP § 2173.05(d).

Further, concerning claim 3 recites the limitations "said rule is determined in a such a manner **that while a point degree owned by a customer increases, a point degree to be displayed decreases**". It appears here that the claim omits essential elements so as to enable one skilled in the art to understand or practice the invention.

Moreover, regarding claim 7, the use of the term "can" in the claim language is improper or renders the claim ambiguous or indefinite.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 USC 102(b) as being anticipated by Golhaber, US Patent 5, 794, 210

As per claims 1-9, Goldhaber discloses a system wherein, in one embodiment, an advertiser 62 creates one or more ads 68 that appeal to certain consumers 64, not to



Art Unit: 3622

others, in accordance with their interest profile 124 (targeted advertisements). The advertiser 62 provides or forwards the created and targeted ads 68 to the Attention brokerage server 106, for permanent storage and later retrieval (storage apparatus), acting as a broker or intermediary between the consumers or viewers 64 and advertisers 62, which transmits or routes the one or more created ads 68 to appropriate consumers 64, upon logging into the system or server 106, contingent upon their psychographic profile 124 (identification data), stored on the Attention brokerage server 106, matching the advertiser's 62 interest profile or criteria (displaying a targeted ad on the viewer's terminal 104 upon identifying the user or viewer when the viewer logs into the server or storage apparatus 106 over the network 102). In short, Attention brokerage servers 106 store information and disseminate it to consumers' computers 104 over a network 102 (Internet) and the servers 106 provide the software agent 110 with targeted or tagged ads, directed to the consumers' or users' attention in accordance with their interest profile 124, to be viewed or reviewed by consumers 64. Moreover, in another embodiment, a software agent 110 related to a user's 64 device or computer 104, working on behalf of the user, screens and filters the incoming ads 68, provided to the Attention brokerage server 106 by advertiser or advertisement owner 62, transmitted by the Attention brokerage server 106 to be displayed to the user 64 based on the user's psychographic information 124 stored on the user's computer 104 local database 120. Subsequent to this screening or filtering process, matches achieving a certain threshold of interest (adjustable by the consumer who owns the profile) represented in the form of "agent reports" consisting of short summaries or thumbnails or pointers are displayed on the user's computer 104, wherein, upon activating a thumbnail view indicative of an ad

Art Unit: 3622

matching, the user's computer 104 or the software agent 110 retrieves the full text and/or graphics corresponding to the matched advertisement 68. In other words, the software agent 110 maintains the user's psychographic or interest profile 124 confidential and performs the screening, filtering and matching itself based on a correlation between the ad criteria presented by the Attention brokerage server 106, on behalf of the advertiser 62, and the user's interest profile 124 stored on the user's computer 104. When matches are found, as indicated by the software agent 110, the Attention brokerage server 106, which stores in a database the advertiser's ads, delivers the matching ads to the user's computer 104 or the software agent 110 may itself retrieve the matching ads from the Attention brokerage server 106 database to be displayed on the user's computer 104.

Alternatively, the software agent 110 may retrieve "thumbnail" brief summaries of the matching ads, associated with a plurality of advertisers, and display them along with associated Cybercoin icons on the user's computer 104, wherein upon activating a Cybercoin icon, showing a related dollar figure, displayed next to a "thumbnail" brief summary representing a matching ad, the ad full text and/or graphics is retrieved and displayed to the user and the user is compensated in an amount equal to the value of the displayed Cybercoin (displaying a point degree in combination with an advertisement from an advertisement owner or advertiser).

(Col. 14: 17 to col. 15: 17; col. 15: 48 to col. 16: 5; col. 19: 26-31; col. 19: 36-61; col. 9: 53-61; col. 6: 24-31; col. 7: 8-19; col. 8: 41-48; col. 10: 9-38).

Further, Goldhaber discloses a method of and system for brokering and selling the attention of a customer wherein, among other things, advertisers pay or compensate the customer for the opportunity to have their ads read by the customer or subscriber of the

Art Unit: 3622

system. By clicking on a Cybercoin button (or banner, ad box or link) or selectable object, displayed on the customer's PC 104 and representative of an ad, the customer indicates his intention to read the said ad and once the system verifies, through a quiz process, that the customer has indeed read or interacted with the ad or advertisement, which guarantees that the advertiser's message has received full human attention or interaction, the customer is compensated in the form of credits or digital cash (points) for paying attention to the ad. **Here, the value of the credits or digital cash (displayed points degree) is equal to the amount shown on the Cybercoin. As time goes by, the customer accumulates a certain amount of credits or digital cash (points balance) for reading a plurality of targeted ads from a plurality of advertisers, wherein the credits balance or digital cash balance (points total) is stored in a database or customer's digital cash repository 126 and the customer's digital cash repository or the customer's account storing the customer's credits is debited for the customer's use or ordering of information unit, medical report, service, goods, movies, etc (redemption of credits or digital cash).**

In addition, Goldhaber discloses a system wherein one or more ad titles or thumbnails are displayed on the customer's terminal along with one or more respective selectable objects or Cybercoins showing the associated monetary amount that the customer will earn if he activates a particular selectable object to read the corresponding advertisement (full version of the ad).

(Col. 16: 6-64; fig. 12; col. 7: 48-61; col. 11: 32-38) and (Col. 4: 47-63; Col. 19: 56-67; figs. 10-11).

Art Unit: 3622

Furthermore, Goldhaber discloses a system wherein advertisers pay users to view their advertising messages in accordance with the user's profile matching the advertisers' criteria or specifications (advertiser's rule to determine a point degree or monetary value of a displayed Cybercoin related to an ad). For example, if a user provides no profile data to an interesting advertiser, then the point degree or the monetary value shown on a displayed Cybercoin, related to an advertisement from an advertiser, is less significant. On the other hand, if the user makes his profile available to the interesting advertiser, who uses the profile information to tailor his ads to the user, then the displayed point degree or monetary value related to the displayed Cybercoin corresponding to the advertisement from the advertiser is more significant (col. 14: 5-10). In another embodiment, the point degree or the monetary value related to a displayed Cybercoin corresponding to an ad from an advertiser is determined based on the highest bid amount offered by an interesting advertiser from a plurality of advertisers for the opportunity to present at least one ad to a targeted user, wherein the bidding process may be silent (passive) or active (advertiser's criteria to determine a point degree...-col. 4: 32-64).

Finally, Goldhaber discloses a system wherein once a user has successfully activated a displayed Cybercoin and adequately read or interacted with the associated advertisement, then the user's digital cash repository 126 is updated or increased accordingly and the displayed Cybercoin is deactivated (or its value is now equal or decreased to zero) to prevent the user from repeatedly clicking on the Cybercoin in the future to read the same advertisement and being compensated for such actions (fig. 12; col. 17: 33-63). It is further recognized that the displayed Cybercoin 62 (selectable object or banner) may be replaced with a coupon icon 63, which performs similar functions

Art Unit: 3622

(sort or type of point degree or Cybercoin 62 or coupon icon 63 monetary value or amount-col. 18: 13-33).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent %, 724, 521 to Dedrick discloses a system for storing a user's profile information, including user's interaction with displayed electronic content and/or advertisements, on the user's computer wherein no outside third party has access to the user's stored profile information.

US Patent 5, 974, 398 to Hanson discloses an interactive information and entertainment service customers see advertisers' bids for their attention which are displayed on their display screens and choose which advertisements to view. For each advertisement viewed, the advertisers' bid amount would pay for a portion of the user's service or usage charge. A display on the user's terminal screen includes the advertisers most willing to pay for the user's attention and the dollar amount bid. If the user chooses to see a particular advertiser's message, then the user is reimbursed, or a credit is applied to the user's service account for the amount of the bid promised by the advertiser whose message was viewed. Customer interest profiles and service usage data collected by the service provider are used to identify particular user characteristics to advertisers. Advertisers define user characteristics of particular desirability and place a dollar value

Art Unit: 3622

on having messages viewed by individual users based on the desirability of the user (See abstract; figs. 4-5).

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

10/16/04



Jean D. Janvier

Patent Examiner

Art Unit 3622